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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,763	10/17/2001	William Sanford	11009-0021	8838

22865 7590 03/09/2006

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MINNEAPOLIS, MN 55344-7704

EXAMINER
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AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/981,763	SANFORD, WILLIAM	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 32-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 32-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Rejections Withdrawn***

1. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heuser made in the last Office action of June 15, 2005 has been withdrawn in view of the amendment filed on December 19, 2005.
2. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (3691662) in view of Heuser has been withdrawn in view of the amendment.
3. Claims -37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heuser has been withdrawn in view of the amendment.
4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham in view of Heuser has been withdrawn in view of the amendment.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 32-37 and new claims 38-43 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1772

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 32-38 and 40-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Riley (6685228).

Riley discloses an alignable label system (22) comprising a die-cut label sheet (20) having a central split line (38), the label sheet being die-cut along a line (32) separating a label from a discardable portion (36). The system further comprises a backing member or laminating strip (44) applied to the label and having a split line (48). An alignment section on the discardable portion is separable from the label and includes an edge to conform to the edge of a folder (abstract). Further, Riley as discloses a method of aligning and applying a label to the edge of a folder comprising the steps of removing a portion of the backing member from the label, aligning the alignment section to the edge of the folder, applying the label, peeling of the remaining backing member and folding the label over the edge (col. 9, lines 4-16). Figures-4 and 5 shows that the alignment line can be curved shaped (82 or 84) and is proximate at least one end of the label.

The top side of the label is adapted for printing (col. 4, lines 34-38).

As shown in figures 4 and 5, the curved edge is "s"-shaped.

The label is adhesive (28) on the surface contacting the backing member.

Figure-4 shows a plurality of labels with die-cut lines therebetween.

Art Unit: 1772

The intended use phrases such as "for two dimensional alignment", "wherein when one portion", "for accurate alignment", "when a portion", etc. have not been given any patentable weight because said phrases are not found to of positive limitations.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riley.

Riley, as discussed above, fails to teach that the curved portion on the discardable portion is spaced from the label. It would have been obvious to one having ordinary skill in the art at the time the invention was made to space the label from the curved portion because, as seen in figure-4 of Riley, the curved portion (82) is perforated and hence, would have tie portions between the cut portions. The tie portions would provide for the spacing of the curved portion from the label.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 32-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 32, the phrases "said label sheet being die cut along a line separating the label from a discardable portion", "said discardable portion", "the discardable part", "alignment of the linear edge with the label" etc. are found to be new matter because the label being die cut and the discardable portion is not supported by the specification as originally filed.

Similarly, claim 34, the phrases "reliably aligning", "simultaneously aligning", etc. are found to be new matter for lack of support in the specification.

Further, claim 38, the phrases "for accurate alignment", "label sheet being die cut", "discardable", etc. are found to be new matter.

Claim 39, the phrase "spaced from said label" is found to be new matter for lack of support in the specification.

Also, claims 41-43, the phrase "discardable" is deemed to be new matter for lack of support in the specification.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1772

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

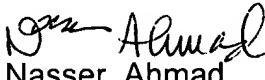
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad 3/4/06  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
March 4, 2006.